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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/767,474	Applicant(s) OLLIS ET AL.	
	Examiner DOHM CHANKONG	Art Unit 2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This final rejection is in response to Applicant's amendment and arguments which were filed on 9/15/2009. Claims 1, 5, 10, and 16 are amended. Claims 1-20 are presented for further examination.

I. RESPONSE TO ARGUMENTS

A. The rejection of claim 1 under 35 U.S.C. § 112, first paragraph is withdrawn.

Applicant argues that the specification does provide support for the step of automatically incorporating GAL contacts. After carefully considering the citations to Applicant's specification, the examiner finds Applicant's arguments persuasive. The rejection of claim 1 under 35 U.S.C. § 112, first paragraph is therefore withdrawn.

B. The rejection of claims 10-15 under 35 U.S.C. § 102(e) as being anticipated by *Huang* is withdrawn in light of Applicant's amendment.

Applicant amends claim 10 to recite that the device actually performs the claimed steps. Unlike the previous claim language, the new limitations must now be considered as part of the claimed system. Therefore, a new ground of rejection which is necessitated by Applicant's amendment is set forth below for claims 10-15.

C. The rejection of claims 1, 3, 5-7, and 9 under 35 U.S.C. § 103(a) as being unpatentable over *Schwartz* and *Kobashikawa* is maintained.

Applicant amends claim 1 with new limitations further specifying that selecting, removing, and providing steps are performed at a server. Applicant argues that *Schwartz* does not disclose "automatically selecting GAL contacts on a server or providing the GAL contacts from the server to the device" [pg. 11]. Applicant's argument is not persuasive because *Schwartz* and *Kobashikawa* teach the new limitations as described below.

Schwartz discloses that “the functions discussed herein can be performed on a client side, a server side or any combination of both” [0052]. So as long as *Schwartz* teaches the claimed steps, it would have been obvious to one of ordinary skill in the art to have implemented the steps at the "server side" based on *Schwartz*'s teaching.

As indicated in the prior action, *Schwartz* does disclose automatically selecting global address list contacts and providing GAL contacts to a client device. Thus, it would have been obvious to one of ordinary skill in the art to have implemented both of these steps at a server.

Moreover, *Kobashikawa* also teaches performing the steps of selecting address list contacts on a server [Fig. 4: displays a web page that allows a user to select and add contacts at a server | column 7 «lines 35-52»] and providing from the server the contacts to a client device [column 5 «line 63» to column 6 «line 6»: synchronizing address books | Fig. 1: where the address books are located at the server and at the client user device]. Thus, coupled with *Schwartz*'s teaching of providing server-side functionality, it would have been obvious to one of ordinary skill in the art to have modified *Schwartz*'s address book system to include the server-based address book functionality described in *Kobashikawa*.

D. The rejection of claims 16, 19, and 20 under 35 U.S.C. § 102(e) as being unpatentable over *Huang* in view of *Kobashikawa* is also maintained.

Applicant amends claim 16 with a new limitation reciting that when a GAL contact is deleted at a client, maintaining a record that indicates the removal of the GAL contact from the automatically selected GAL contacts before providing the GAL contacts to the device during a subsequent synchronization. Applicant's arguments have been considered but are not persuasive because *Huang* still teaches this new feature.

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Specifically, *Huang* discloses “during synchronization, if an address in DAB 132 of host device 102 is no longer in DABI 130 of client device 106, then the corresponding entry in DAB 132 is deleted” [column 5 «lines 30-32»]. In other words, when a client deletes an address from his address book (i.e., DABI 130), *Huang*’s system does not synchronize that contact with the automatically selected GAL contacts (i.e., DAB 132).

Huang further discloses maintaining a record in the form of a message in a queue to indicate to the server that the address was deleted and therefore should not be synchronized with the client device (i.e., it is removed at the server side) [column 6 «lines 52-60»: “changes to the PAB are queued on PC”].

The queue on the PC represents a record of the deleted address and serves as an indication to not synchronize that deleted address. *Huang*’s queue therefore reads on the claimed record. For the foregoing reasons, Applicant’s new limitation to claim 16 does not overcome the *Huang* reference.

E. Conclusion

For the foregoing reasons, the rejection of claims 1, 3, 5-7, and 9 under *Schwartz* and *Kobashikawa* are maintained as set forth in the previous action. The new limitations to these claims are further addressed below. The rejection of claims 2, 4, and 8 are maintained for similar reasons. The rejection of claims 10-15, 16, 19, and 20 are withdrawn in view of Applicant’s amendments. New grounds of rejection which were necessitated by Applicant’s amendment are set forth below for these claims.

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II. CLAIM REJECTIONS - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

A. Claims 1, 3, 5-7, and 9 are rejected under 35 U.S.C. 103(a) as being obvious over *Schwartz et al*, U.S. Patent Publication NO. 2004|0135816 [*"Schwartz"*] in view of *Kobashikawa et al*, U.S. Patent NO. 7.539.699 [*"Kobashikawa"*].

The applied reference *Schwartz* has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

All citations are to *Schwartz* unless otherwise noted.

Claim 1

Schwartz as modified by *Kobashikawa* discloses a method for populating a list of GAL contacts on a device, comprising:

automatically selecting global address list (GAL) contacts on a server for a user to include on the device in addition to user's personal contacts that are already stored on the device [0021: tracking "non-address book message targets" | 0052: step may be performed server side | *see also Kobashikawa*, Fig. 4: displays a web page that allows a user to select and add contacts at a server | column 7 «lines 35-52»];

on the server, removing any duplicates from the GAL contacts to ensure that the GAL contacts are unique from the user's personal contacts [0044: separate list of new recipients - therefore the addresses in the "non-address book" are unique | 0052: step may be performed server side];

preparing the GAL contacts [0044] to provide to the device including limiting a number of GAL contacts to be provided to the device [*Kobashikawa*, column 5 «lines 46-52»: limiting the addresses based on predefined criteria]; and

providing from the server the GAL contacts to the device [0044, 0052 | *see also Kobashikawa*, column 5 «line 63» to column 6 «line 6»: synchronizing server and client address books];

wherein the GAL contacts are incorporated with the user's personal contacts [0044] and wherein a display of the GAL contacts are visually distinguishable from the user's personal contacts when displayed together within a contact view on the device [*Kobashikawa*, Fig. 2

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«items 172, 174»: disclosing separating addresses into different folders but within the same contact view | column 6 «line 46» to column 7 «line 7»];

wherein the user's personal contacts are treated differently from the provided GAL contacts such that the user's personal contacts are maintained during a synchronization that updates the provided GAL contacts [0044 – the non-address book is updated while the user's personal address book is maintained].

As noted above, *Schwartz* does not expressly disclose (1) limiting the number of contacts to be provided to a client device or (2) a display where the GAL contacts are visually distinguishable from the user's personal contacts when displayed together within a contact view. However, both features were well known in the art at the time of Applicant's invention as evidenced by *Kobashikawa*.

1. *Kobashikawa* teaches limiting the number of contacts provided to the user based on predefined criteria.

Like *Schwartz*, *Kobashikawa* is directed to an invention for organizing contact addresses into an address book. *Kobashikawa* further discloses synchronizing address books between the server and the user device (i.e., providing addresses from the server to the user). Before performing this step, the number of addresses may be limited by predefined criteria [column 5 «lines 46-52»].

It would have been obvious to one of ordinary skill in the art to have modified *Schwartz* to include the ability to limit the number of contacts that are provided to the user device. Such a modification would have improved *Schwartz*'s system because it has the advantage of only providing the most relevant addresses to the user [see *Kobashikawa*, column 5 «lines 47-49»].

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2. *Kobashikawa* teaches providing a display that visually distinguishes between GAL and user's personal contacts.

Kobashikawa further discloses organizing different contacts into different folders in manner that allows the user to visually distinguish between contacts (because the contacts are placed and displayed in different folders). In other words, because the contacts are in separate folders but within the same view, they are visually distinguishable to the user.

It would have been obvious to one of ordinary skill in the art to have modified *Schwartz* with this same feature to better organize the user's contact list. For example, *Schwartz* discloses three different lists: an MFU (most frequently used) list, a list of non-address book recipients, and a general contact list.

As modified by *Kobashikawa*, *Schwartz* would organize these different lists into different folders (an MFU folder, a folder for contacts that are not currently in the address book, and a folder for general contacts) so that they can be displayed together but still visually distinguishable. Using folders to organize contacts but also display them within the same contact window would improve *Schwartz* by better organizing the user's contacts.

Claim 3

Schwartz discloses automatically selecting the global GAL contacts further comprises obtaining the GAL contacts from a user's emails including obtaining a primary addressee from each of a predetermined number of sent emails from the user [0044].

Claim 5

Schwartz discloses determining when one of the GAL contacts on the device is removed by the user and when one of the GAL contacts on the device is removed by the user preventing the removed GAL contact from being provided to the device during a subsequent

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synchronization after being automatically selected [0043: removing an entry from the list implies that the entry will not be added to the personal address book].

Claim 6

Schwartz discloses determining when the user edits one of the GAL contacts on the device; and when the user has edited one of the GAL contacts on the device making the one of the GAL contacts one of the personal contacts on the user's device [0044].

Claim 7

Schwartz discloses limiting the number of GAL contacts provided to device [0043].

Claim 9

Schwartz discloses the GAL contacts are obtained from a GAL store on a server [0052: discussing how all the features of the invention can be performed server side].

B. Claims 10, 11, and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Huang et al*, U.S. Patent No. 5,966,714 ["*Huang*"], in view of *Kobashikawa* and *Schwartz*.

Claim 10

Huang as modified by *Kobashikawa* discloses a system for populating a list of GAL contacts on a device, comprising:

a device including a communication connection, a data store, a display, and a processor that performs the following actions [Figure 1a «item 106» | Figure 1c «item 106» | column 5 «lines 36-37»], including:

connecting to a network using the communications connection to perform a synchronization [column 5 «lines 17-42»];

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receiving an update list from the network containing information to update global address list (GAL) contacts that are unique from a user's personal contacts [*column 2 «lines 27-31»* : a change list | *column 4 «lines 5-10»* : generating a subset of a large address book] and are in addition to the user's personal contacts [*Fig. 3e «steps 347-355»*];

wherein the GAL contacts are synchronized differently from the user's personal contacts [*Schwartz, 0044*]; and

wherein the GAL contacts are visually distinguishable within a contact view from the user's personal contacts [*Kobashikawa, Fig. 2 «items 172, 174»*: disclosing separating addresses into different folders but within the same contact view | *column 6 «line 46»* to *column 7 «line 7»*];

updating the GAL contacts [*column 4 «line 62»* to *column 5 «line 1»* | *column 6 «lines 60-64»*];

storing the updated GAL contacts in the data store [*column 4 «lines 50-54»* : memory within the client device]; and

displaying the GAL contacts on the display [*Figure 1d*]; and

when an edit is made to one of the GAL contacts while stored on the device adding the edited GAL contact as a personal contact to the user's personal contacts on the device [*Fig. 3e «step 353, 354»*];

a server including a communications connection, a data store, and a processor that performs the following actions [*Figure 1c «items 127, 102»*], including:

obtaining the GAL contacts for the user [*column 6 «lines 8-12»*];

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preparing an update list based on the GAL contacts in the data store on the device and the obtained GAL contacts [*column 7 «lines 26-32» | Figure 3e «item 350»* : preparing the information from the master address book | *column 9 «lines 63-66»*]; and providing the GAL contacts to a device over the network [*Figure 3e «item 355» | column 9 «lines 63-66»*].

As indicated in the foregoing mapping, *Huang* does not expressly disclose (1) wherein the GAL contacts are synchronized differently or (2) the GAL contacts are visually distinguishable within a contact view from the user's personal contacts. However, both of these features were well known in the art at the time of Applicant's invention as evidenced by *Schwartz* and *Kobashikawa*.

1. *Schwartz* discloses synchronizing the GAL contacts differently from the user's personal contacts.

Specifically, *Schwartz* discloses that the non-address book is updated while the user's personal address book is maintained [0044]. It would have been obvious to one of ordinary skill in the art to have modified *Huang's* address book system to include *Schwartz's* teaching. Such a modification is an example of applying a known technique (*Schwartz's* synchronization feature) to a known system (*Huang's* address book system) ready for improvement to yield predictable results (*Huang's* system improved to allow for differentiated synchronization as taught in *Schwartz*).

2. *Kobashikawa* teaches visually distinguishing between GAL and user's personal contacts.

Kobashikawa discloses organizing different contacts into different folders in manner that allows the user to visually distinguish between contacts (because the contacts are placed and

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displayed in different folders). In other words, because the contacts are in separate folders but within the same view, they are visually distinguishable to the user.

It would have been obvious to one of ordinary skill in the art to have modified *Huang* with this same feature to better organize the user's contact list. As modified by *Kobashikawa*, *Huang* would organize his lists into different folders (an MFU folder, a folder for contacts that are not currently in the address book, and a folder for general contacts) so that they can be displayed together but still visually distinguishable. Using folders to organize contacts but also display them within the same contact window would improve *Huang* by better organizing the user's contacts.

Claim 11

Huang discloses automatically selecting the GAL contacts further comprises obtaining the GAL contacts from the user's emails [*column 5 «line 67» to column 6 «line 7»*].

Claim 15

Huang discloses displaying the GAL contacts along with the user's personal contacts [*Figure 1d*].

C. Claims 16, 19, and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Huang* in view of *Kobashikawa*.

Claim 16

Huang discloses a computer-readable storage medium including computer-executable instructions for populating a list of GAL contacts on a device, comprising:

beginning a synchronization session [*column 4 «lines 5-18»*];

automatically selecting global address list (GAL) contacts for a user that in addition to a

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user's personal contacts on the device and that are unique from the user's personal contacts from the user's emails [*column 4 «line 50» to column 5 «line 4»*] : receiving only a subset of the larger address book | *column 6 «lines 1-14»* | *Figure 3e «item 347»* : selecting contacts based on scanning email addresses from a user's Email folders and archives and determining whether the address is already in the user's personal address book (PAB)];

wherein the GAL contacts on the device are synchronized differently from the user's personal contacts on the device [Fig. 3e] such that when a GAL contact is deleted on the device, a record is maintained indicating to remove the GAL contact from the automatically selected GAL contacts [*column 5 «lines 30-32»*: the address is deleted from the server's address book], before providing the GAL contacts to the device during a subsequent synchronization [*column 6 «lines 52-60»*: the queue serves as a record of the deleted address] ; and

wherein the GAL contacts are visually distinguishable within a contact view on the device from the user's personal contacts [*Kobashikawa*, Fig. 2 «items 172, 174»]: disclosing separating addresses into different folders but within the same contact view | *column 6 «line 46» to column 7 «line 7»*];

providing the GAL contacts to a device [*Figure 3e «item 355»* | *column 9 «lines 63-66»*].

As noted above, *Huang* does not expressly disclose a display where the GAL contacts are visually distinguishable from the user's personal contacts when displayed together within a contact view. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by *Kobashikawa*. Like *Huang* *Kobashikawa* is directed to an invention for organizing contact addresses into an address book. *Kobashikawa* further discloses organizing

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different contacts into different folders in manner that allows the user to visually distinguish between contacts (because the contacts are placed and displayed in different folders).

In other words, because the contacts are in separate folders but within the same view, they are visually distinguishable to the user. It would have been obvious to one of ordinary skill in the art to have modified *Huang* with this same feature to better organize the user's contact list. For example, *Huang* discloses organizing messages into folders as well as retrieving only a subset of addresses from the personal contact list.

As modified by *Kobashikawa*, *Huang* would organize these different folders and the subset of contacts that are sent to the mobile device into different contact folders (such as a mobile phone contact folder) so that they can be displayed together but still visually distinguishable. Using folders to organize contacts but also display them within the same contact window would improve *Huang* by better organizing the user's contacts.

Claim 19

Huang discloses providing the GAL contacts to the device further comprising providing updates to the device in order to update a GAL contact store on the device [*column 4 «line 62» to column 5 «line 1» | column 6 «lines 60-64»*].

Claim 20

Huang discloses maintaining a user snapshot list outside of the device that is related to the GAL contacts for the user [*Figure 1c «item 128» | column 6 «lines 37-40»* : snapshot of the highest ranked addresses stored at the host device (outside of the user's mobile device)].

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D. Claims 12, 14, and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Huang and Kobashikawa*, in further view of *Kraenzel et al*, U.S. Patent Publication No. 2005|0198144 [*“Kraenzel”*].

As to claims 12, 14, and 17, *Huang* does disclose obtaining a primary addressee from sent emails from the user [*column 5 «line 67» to column 6 «line 7» | column 7 «lines 62-65» | column 9 «lines 44-67»*], but does not expressly disclose scanning a predetermined number of sent emails from the user. However, the feature of specifying a number of sent emails to be retrieved and scanned was well known in the art at the time of Applicant's invention as evinced by *Kraenzel*.

Kraenzel is directed towards a system for managing message addressed by extracting the information from emails [*abstract*]. *Kraenzel* discloses that a user can specify the number of emails to search to extract the addressee information [*Figure 3 : specifying number of messages if more than a certain number | 0060-0062*]. It would have been obvious to one of ordinary skill in the art to have adapted *Huang*'s system to include *Kraenzel*'s user selectable filters. One would have been motivated to adapt *Huang* because the filters increase the amount of control that a user has over the number of messages to be scanned.

E. Claims 13 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Huang and Kobashikawa*, in further view of *Lake*, U.S. Patent No. 7.200.638.

As to claims 13, and 18, *Huang* does not expressly disclose obtaining the GAL contacts from meeting requests. However, the feature of extracting contact information from meeting requests was well known in the art at the time of Applicant's invention as evinced by *Lake*. *Lake* is directed towards a system for automatically populating a contact list [*abstract*]. *Lake* teaches that one of the ways to accomplish this task is to extract the contacts from meeting information

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found in a user's calendar [*Figure 3 | column 2 «lines 6-11»*]. It would have been obvious to one of ordinary skill in the art to have adapted *Huang's* system to include *Lake's* automatic population functionality. *Lake* teaches that such a feature more efficiently manages a user's contact list [*column 1 «lines 51-62»*].

F. Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Schwartz* and *Kobashikawa*, in further view of *Kraenzel*.

As to claim 2, *Schwartz* discloses obtaining the GAL contacts from emails [abstract] but does not disclose obtaining the GAL contacts from other forms of communication. However, extracting contact information from a variety of communications was a well known feature in the art at the time of Applicant's invention as evidenced by *Kraenzel*. *Kraenzel* teaches obtaining contacts from phone calls, SMS or IM messages, and user meetings [0030, 0031: discussing the application of his extraction feature in a variety of products including instant messaging, discussion forums or other multi-part communication systems]. It would have been obvious to one of ordinary skill in the art that the forms of communication being claimed in claim 2 are contemplated by *Kraenzel* as multi-part communication systems. It would have been further obvious to one of ordinary skill in the art to have modified *Schwartz's* system with the ability to obtain contacts from a wider variety of communications as taught by *Kraenzel*. Such a modification substantially increases the number of contacts that may be included in the contact list.

G. Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Schwartz* and *Kobashikawa*, in further view of *Lake*.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C.

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102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Claim 4

As to claim 4, *Schwartz* does not expressly disclose obtaining the GAL contacts from meeting requests. However, the feature of extracting contact information from meeting requests was well known in the art at the time of Applicant's invention as evidenced by *Lake*. *Lake* is directed towards a system for automatically populating a contact list [*abstract*]. *Lake* teaches that one of the ways to accomplish this task is to extract the contacts from meeting information found in a user's calendar [*Figure 3 | column 2 «lines 6-11»*]. It would have been obvious to one of ordinary skill in the art to have adapted *Schwartz*'s system to include *Lake*'s automatic population functionality. *Lake* teaches that such a feature more efficiently manages a user's contact list [*column 1 «lines 51-62»*].

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H. Claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Schwartz and Kobashikawa*, in further view of *Calder et al*, U.S. Patent Publication No. 2001|0034244 [*"Calder"*].

Schwartz does disclose maintaining a snapshot list that excludes the user's personal contacts [0044] but does not disclose maintaining a snapshot list outside of the device. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by *Calder*. *Calder* discloses maintaining several snapshot lists outside of the user's device [Fig. 4 | 0054: disclosing multiple fone lists that may be individually downloaded to the handset]. *Calder* discloses the benefit of this feature allows a user to maintain a variety of contact lists for different purposes and downloading them as needed [0055: a list for contacts from a first country and a list for contacts from a second country]. Therefore, it would have been obvious to one of ordinary skill in the art to have modified *Schwartz* to include the snapshot list feature as taught by *Calder*.

III. CONCLUSION

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday to Friday [10 am - 6 pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on (571)272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOHM CHANKONG/
Primary Examiner, Art Unit 2452